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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/494,297	01/31/00	PODBIELSKI	A P06628US0/BA

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HM12/0626

EXAMINER

MINNIFIELD, N

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

06/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/494,297

Applicant(s)

PODBIELSKI

Examiner  
N. M. Minnifield

Art Unit  
1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) 5-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☒ Claims 1-18 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other:

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#### DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-4, and species election Cpa1 (SEQ ID NO: 1 and 2) in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 5-18 and species Cpa49 (SEQ ID NO:3 and 4) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.
3. The disclosure is objected to because of the following informalities: the specification does not have a complete reference citation for Okada et al 1994. Applicants are encouraged to check all reference citations in specification text and at end of specification.  
Appropriate correction is required.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(a/b) as being anticipated by Podbielski et al 1999.

The claimed invention is directed to an isolated nucleic acid molecule encoding a collagen-binding protein, wherein said collagen-binding protein is isolated from group A *Streptococcus* bacteria.

Podbielski et al discloses the nucleic acid molecule and gene for the collagen binding protein from a group A *Streptococcus* bacteria (abstract; figure 1; table 1; p. 1053, col. 2; materials and methods). The prior art anticipates the claimed invention.

Since the Office does not have the facilities for examining and comparing applicants' product with the product of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the nucleic acid encoding collagen-binding protein from a group A *Streptococcus* bacteria of the prior art does not possess the same material structural and functional characteristics of the claimed nucleic acid

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encoding collagen-binding protein from a group A *Streptococcus* bacteria). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

6. Claims 2-4 appear to be free of the prior art.
7. It is noted that the formal drawings are now required and that Applicant should comply with the objections to the drawings as set forth in Form 948 (Draftsperson's Notice) mailed with this paper. Applicant should make sure that the figure descriptions set forth in the specification match the formal drawings that will be submitted.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is (703) 305-3394. The examiner can normally be reached on Monday-Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.  
  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R. F. Smith, can be reached on (703) 308-3909. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

N. M. Minnifield

June 21, 2001

  
N. M. MINNIFIELD  
PRIMARY EXAMINER